

**REMARKS**

Review and reconsideration on the merits are requested.

Claims 23-42 were rejected under 35 U.S.C. § 112, second paragraph. The Examiner considered claims 23, 27 and 36 as not clearly defining the intended scope of protection, and particularly, whether Applicants intend to include step (a) of forming a silver salt of an organic acid as part of the process of forming a thermally processed image recording material, or whether step (a) is intended as an intermediate step for producing the subject silver salt of an organic acid. The Examiner further considered claim 36 to be unclear as to whether the coated solution of step (b) contains the grains of the silver salt of an organic acid produced in step (a) or otherwise.

Claims 23-42 were also rejected under 35 U.S.C. § 112, first paragraph. The Examiner considered that the specification as originally filed does not support the claimed method of producing a thermally processed image recording material including step (a) of preparing grains of silver salt of an organic acid.

In response, claims 23, 27 and 36 have been amended to clearly recite that the method includes the step of (a) providing a dispersion or aqueous dispersion of grains of silver salt of an organic acid which have been prepared by the various techniques described in the specification, and applying a coating solution containing the dispersion of grains of silver salt of an organic acid prepared by step (a). The subject matter of the amended claims is fully supported by the specification, for example, at page 12, lines 1-13 and in claims 19-21, 23, 27, 36 as originally filed.

It is respectfully submitted that the claims as amended fully comply with 35 U.S.C. § 112, and withdrawal of the foregoing rejections is respectfully requested.

Claims 23-42 were rejected under 35 U.S.C. § 102(a) as being anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 6,783,925 to Yasuda.

Claims 23-42 were rejected under 35 U.S.C. § 102(a) as being anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over EP 1069468 (EP '468). Claims 23-42 were rejected under 35 U.S.C. § 102(a) as being anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over EP 1063566 (EP '566). Claims 23-42 were rejected under 35 U.S.C. § 102(a) as being anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over EP 0962812 (EP '812).

The grounds for rejection remain the same as set forth in the previous Office Action.

In the Examiner's view, the applied prior art discloses the claimed method for producing a thermally processed image recording material, which essentially includes the step of applying a coating solution to a support, and that the method used to prepare the grains of silver salt of an organic acid is immaterial to patentability. In other words, the Examiner did not consider the steps used to prepare the grains of silver salt of an organic acid to be relevant, as being independent from the method of producing the thermally processed image recording material. Additionally, the Examiner contends that the verified English translation of the priority document fails to support the invention of claims 23-35, or a process for producing a thermally processed image recording material using step (a) and (b) in combination (as claimed in claims 23-42).

Applicants respond as follows.

The material on which a process is carried out must be accorded weight in determining the patentability of the process (MPEP §2116), and in this case, the use of grains of silver salt of an organic acid prepared by the processes defined in step (a) of claims 23, 27 and 36 provides a thermally processed image recording material which is different, in an unobvious way, from prior art thermally processed image recording materials prepared using a coating solution containing an *ordinary* dispersion of grains of silver salt of an organic acid.

In this regard, Tables 1-3 of the present specification at pages 88, 107 and 111, respectively, fully demonstrate that the materials produced by the claimed method exhibit superior effects. One skilled in the art would not have readily predicted such superior effects before the claimed invention was made.

For example, Table 2 at page 107 of the specification shows enhanced photographic performance, and particularly a lower fog increase ratio (indicating better storage stability) for a thermally processed image recording material prepared by the inventive method as compared to thermally processed image recording materials prepared using a coating solution containing an ordinary dispersion of grains of silver salt of an organic acid.

Applicants further comment as follows.

Yasuda, U.S. Patent 6,783,925 is silent as to the step of "supplying the solution containing silver ions into a reaction field solution before being introduced into the sealed mixing means" (Claim 23). The method disclosed by Yasuda does not satisfy "removing by-product salts contained in the reaction mixture by filtration through an ultrafiltration membrane

during or after the reaction" (Claim 27) and "removing by-product salts by ultrafiltration after or during the dispersing operation" (Claim 36). Yasuda merely carries out ultrafiltration prior to the dispersing operation.

The method disclosed by EP 1069468 does not satisfy "supplying the solution containing silver ions into a reaction field solution before being introduced into the sealed mixing means" (Claim 23). Furthermore, EP 1069468 is silent as to ultrafiltration (Claims 27 and 36).

EP 1063566 is silent as to closed mixing means (Claims 23 and 27). Claim 36 is described in the priority document (Japanese Patent Application No. 236044/2000 filed on August 3, 2000). The Examiner is respectfully requested to refer to Claim 9 at pages 1-2 of the verified English translation. The priority document supports a process for producing a thermally processed image recording material using step (a) and (b) in combination.

EP 0962812 is silent as to the closed mixing means (Claims 23 and 27). EP 0962812 fails to disclose "removing by-product salts by ultrafiltration after or during the dispersing operation" (Claim 36).

Thus, each of the applied references is missing one or more elements of the claimed invention as claimed in independent claims 23, 27 and 36, such that the above rejections cannot stand. Yasuda, EP 1069468, EP 1063566 and EP 0962812 do not teach every element of claims 23, 27 and 36 and therefore do not anticipate. MPEP §2131. Furthermore, these same references do not teach or suggest all claim limitations such that a *prima facie* case of obviousness has not been established. MPEP §2143.03.

For the above reasons, it is respectfully submitted that the present claims are patentable over the cited prior art, and withdrawal of the foregoing rejections is respectfully requested.

Withdrawal of all rejections and allowance of claims 23-42 is earnestly solicited.

In the event that the Examiner believes that it may be helpful to advance the prosecution of this application, the Examiner is invited to contact the undersigned at the local Washington, D.C. telephone number indicated below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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Abraham J. Rosner  
Registration No. 33,276

SUGHRUE MION, PLLC  
Telephone: (202) 293-7060  
Facsimile: (202) 293-7860

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